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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/459,774 12/13/99 BARNES

M GP-30193

EXAMINER

HM12/1222

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ZEMAN, R

ART UNIT

PAPER NUMBER

1645

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DATE MAILED:

12/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/459,774

Applicant(s)
Barnes et al.

Examiner
Robert A. Zeman

Group Art Unit
1645



☒ Responsive to communication(s) filed on Oct 18, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2, 5-9, and 11-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 2, 5-9, and 11-13 is/are allowed.

☒ Claim(s) 14-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

Claims 2, 5-9 and 11-18 are pending and currently under consideration.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: **Human WNT7a polynucleotides**

Claim Objections Withdrawn

The objection to claims 5-9 for being dependent upon a non-elected claim is withdrawn in light of the amendment thereto.

Claim Rejections Withdrawn

35 USC § 112

The rejection of claim 2 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polynucleotides with at least a 99.5% sequence identity with SEQ ID NO:1 and polynucleotides that encode for polypeptides with at least 99% identity with SEQ ID NO:2, does not reasonably provide enablement for “variants and fragments” of RNA

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complementary to the aforementioned polynucleotides is withdrawn in light of amendment thereto.

The rejection of claims 2 and 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the amendment thereto..

The rejection of claim 2 under 35 U.S.C. 112, second paragraph, for being rendered vague and indefinite by the use of improper Markush language is withdrawn in light of the amendment thereto.

The rejection of claim 2 under 35 U.S.C. 112, second paragraph, for being rendered vague and indefinite by the use of the term "variants and fragments" in the penultimate line of said claim is withdrawn in light of the amendment thereto.

The rejection of claims 5-6 under 35 U.S.C. 112, second paragraph, for use of the term "capable of " is withdrawn in light of the amendment thereto.

Claim Rejections - 35 USC § 102

The rejection of claim 2 under 35 U.S.C. 102(b) as being anticipated by Ikegawa et al. (Cytogenetics and Cell Genetics, 1996 Vol. 74 pages 149-152) is withdrawn in light of the amendment thereto.

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The rejection of claim 2 under 35 U.S.C. 102(b) as being anticipated by Bui et al. (Gene Vol. 189 pages 25-29, 1997, IDS-6) is withdrawn in light of the amendment thereto..

The rejection of claim 2 under 35 U.S.C. 102(b) as being anticipated by Gavin et al. (Genes and Development Vol. 4 pages 2319-2322, 1990) is withdrawn in light of the amendment thereto.

Claim Rejections - 35 USC § 103

Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikegawa et al. (Cytogenetics and Cell Genetics ,1996 Vol. 74 pages 149-152), as applied to claim 2, above, in view of Sambrook et al. (Molecular Cloning A Laboratory Manual Second Edition. Cold Spring Harbor Laboratory Press, Plainview, New York. 1989) is withdrawn in light of the amendment thereto.

New Claim Rejections

Claim Rejections - 35 USC § 112

Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 15-16 are rendered vague and indefinite by the use of the term "RNA equivalent". It is unclear what is meant by an equivalent. Is applicant referring to mRNA? tRNA? single stranded RNA? Double Stranded DNA? As written it is impossible to determine the metes and bounds of the claimed invention.

Claims 17-18 are rendered vague and indefinite by the use of the term "complementary". It is unclear what properties make a sequence "complementary". As written, it is impossible to determine the metes and bounds of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Ikegawa et al. (Cytogenetics and Cell Genetics, 1996 Vol. 74 pages 149-152).

Ikegawa et al. disclose a nucleic acid sequence for **human WNT7a** that is 99.5% identical to the nucleic acid of the claimed invention and an amino acid sequence that is 99.4% identical to the polynucleotide of the claimed invention (see Figure 1 on page 150 and STIC sequence search report, attached). Said polynucleotide would be isolatable by claimed

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polynucleotide. Consequently, Ikegawa et al. clearly anticipate all the elements of the claimed invention.

Conclusion

Claims 2, 5-9 and 11-13 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.

A handwritten signature in black ink, appearing to read 'D. Wortman', with a stylized flourish at the end.

DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

December 18, 2000